

### **REMARKS**

The Office Action has been carefully reviewed. Claims 1-31 are pending. Claims 1, 12, 14 and 31 have been amended to clarify the various embodiments of the present inventions. No new matter has been added. Applicant respectfully requests reconsideration for at least the following reasons.

#### **I. Objections to the Drawings.**

In response to the Examiner's objections that Figs. 1 and 2 lack names, Applicant submitted replacement Figures 1 and 2. *See* Response filed April 22, 2008. Applicant respectfully requests acknowledgement and acceptance of these replacement figures and withdrawal of the current drawing objections.

#### **II. Rejections Under 35 U.S.C. § 102.**

Claims 1-31 are currently rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Publication No. 2002/0077964 to Brody *et al.* ("Brody").

An embodiment of the present invention is directed to pre-qualifying a consumer for one or more financial instruments without a request by the consumer. *See, e.g.*, Specification, page 8, lines 3-7; page 9, line 19-page 10, line 3; page 18, lines 7-8. An embodiment of the present invention offers financial instruments to consumers in essentially real-time because the financial institution has, *prior to the time of contact by the consumer*, identified the consumer, accumulated information relating to that consumer to determine the consumer's qualification for specific financial instruments. *See, e.g.*, Specification, page 13, lines 8-4.

In contrast, Brody is directed to providing consumers anonymous pre-approved offers from a consumer-selected group of merchants. *See, e.g.*, Brody, Abstract, [0068]. According to Brody, the consumer submits a request to receive personalized credit related information. *See,*

*e.g.*, [0062]. Based on the consumer request, the system of Brody transmits an inquiry to a credit bureau. *Id.* After a consumer's account is established and after indicating that the consumer wishes to receive pre-approved offers, the consumer is directed to a webpage to select the type of offers the consumer wishes to receive. *See, e.g.*, [0069]. Therefore, the system of Brody is consumer-initiated. *See also* [0068], Brody claim 1 reciting "receiving a request from the consumer for personalized credit-related information" and "transmitting to a credit bureau, in response to the request from the consumer."

Independent claim 1 recites "the consumer information being transmitted *prior to a consumer contact.*" Independent claims 12, 14 and 31 recite similar limitations. In sharp, irreconcilable contrast, Brody acts as an agent of a consumer and **requires** a consumer inquiry. Brody recites

Because the present invention acts on behalf of consumer's the administrator of the present invention can be considered an agent of the consumer. Acting as an agent of the consumer, the consumer's credit files can be retrieved based upon a consumer inquiry, because the purpose of the inquiry is for the consumer's primary benefit. **According to the present invention, the system and method do not provide the customer's credit information to merchants or other entities, unless a consumer wishes to enter a contract with a particular entity,** as described below.

Brody, [0066] (emphasis added). The Office Action relies on paragraph [0062] which recites "[a]ccording to one aspect of the invention, the system of the present invention can request credit reports from any credit bureau...." *See* Office Action, page 4 (citing paragraph 62, line 18-20, paragraph 64 and figure 3). The excerpt relied upon by the Office Action fails to disclose "the consumer information being transmitted *prior to a consumer contact.*" In fact, Brody emphasizes that "[t]o receive merchant offers, **consumers must give permission** to look at the consumer's credit information, such as credit reports maintained by credit bureaus..." *See*

Brody, [0003] (emphasis added). The Office Action fails to even address this inconsistency. Therefore, as the claim recitation is not disclosed by Brody, the rejection is improper and should be withdrawn.

Furthermore, the citation relied upon by the Office refers to blocks 104 and 106 of Figure 3. Applicant notes that block 100 of Figure 3, which occurs chronologically earlier in the method, recites “authorized/authenticated **consumer requests** credit scoring function.” Similarly the first step in Figure 4 recites “authorized/authenticated **consumer requests** e-privacy function.” Additionally, the first step in figures 5 and 6 require a request from a consumer. Thus, every flowchart in Brody indicates that a consumer must first request the transmission of information. Brody, as illustrated above, teaches that a consumer is required to provide a request in order to give permission to transmit information. Clearly, Brody fails to disclose “the consumer information being transmitted *prior to a consumer contact*.” In fact, Brody teaches the opposite. Therefore, as the claim recitation is not disclosed by Brody, the rejection is improper and should be withdrawn. Moreover, one skilled in the art would not have been motivated to modify Brody to meet the claimed inventions. Doing so would change a principle of operation of the reference and render the reference unusable for its intended purpose.

In addition, independent claim 1 recites “information associated with *a consumer who is a customer of a financial institution or an entity associated with the financial institution*” and “at least one financial instrument [is] *associated with the financial institution*.” Independent claims 12, 14 and 31 recite similar limitations. In contrast, Brody discloses a method in which consumers can **anonymously** receive pre-approved offers from a plurality of merchants. *See* [0068]. As recited in the claims, the consumer is a customer of the financial institution or an entity associated with the financial institution, and therefore is not anonymous. The specification

of the instant application supports this feature on at least page 5, lines 10-14 ("By marketing financial products only to consumers who pass the financial institution's criteria for a certain financial instrument, and who have already come in contact with the financial institution or one of its business partners, the financial institution generates significantly lower acquisition cost for each consumer and creates a superior customer experience."). As Brody fails to meet at least this claim limitation, the rejections are improper and should be withdrawn.

Moreover, independent claim 12 recites "*a suppression database* comprising a plurality of second consumer files, each of the second consumer files linked to the unique consumer identifier of a consumer, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file." The Office Action fails to address at least this claim limitation and therefore fails to meet its burden. Moreover, Brody fails to provide any disclosure or teaching related to the claimed suppression database. For at least these reasons, independent claim 12 is patentable over Brody.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Celeritas Tech., Ltd., v. Rockwell Int'l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). Because the Brody fails to teach each and every element of the claimed invention, the Office has failed to establish a prima facie case of anticipation.

Regarding claims 2-11, 13, and 15-30, these claims are dependent upon independent claims 1, 12, and 14 respectively. Thus, since independent claims 1, 12, and 14 should be

allowable as discussed above, claims 2-11, 13, and 15-30 should also be allowable at least by virtue of their dependency on independent claims 1, 12, and 14.

**CONCLUSION**

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:

  
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Yisun Song  
Registration No 44,487

Dated: June 12, 2008

Hunton & Williams LLP  
Intellectual Property Department  
1900 K Street, N.W.  
Suite 1200  
Washington, DC 20006-1109  
(202) 955-1500 (telephone)  
(202) 778-2201 (facsimile)